



Atty. Docket: 15-UL-6174

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Application of:

Gopal B. Avinash et al. : Group Art Unit: 2624

Serial No.: 10/064,873 : Examiner: Seth, M.

Filed: August 26, 2002

Title: SYSTEM AND METHOD FOR PROCESSING
ANNOTATED SCREEN CAPTURE IMAGES BY
AUTOMATED SELECTION OF IMAGE REGIONS

Hon. Commissioner for Patents
Alexandria, VA 22313

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In accordance with the OG Notice of July 12, 2005, the Applicants hereby request review of the Final Rejection mailed on February 22, 2007 in the above-referenced application. A Notice of Appeal is being filed concurrently herewith.

I. Section 112 Rejection of Claims 33-48

In ¶ 4 of the February 22, 2007 office action, claims 33-48 were finally rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicants submit that this rejection is clearly erroneous for the following reasons.

In support of the Section 112 rejection, the Examiner asserts that no support can be found in the claims and specification as originally filed for "the process of adding annotations to the image." The Examiner makes this assertion despite conceding that this step is disclosed in ¶ 0002 of the Background of Invention section in the original specification.

It is well settled that a claim may include limitations from the prior art so long as the claim includes an additional non-obvious limitation not found in the prior art. For example, a Jepson claim may be submitted in which the preamble recites the state of the art and the remainder recites an improvement over the prior art. Thus, on its face, it is clear error to assert that a claim limitation cannot find support in the Background section of the specification.

Moreover, in the instant case the Examiner is clearly wrong because a portion of Applicants' specification, not in the Background section, provides a clear basis for the recited step of "adding data representing a textual annotation to said acquired grayscale image data," recited in Applicants' claim 33. Specifically, ¶ 0023 states: "The process starts with a screen capture image 28 having one or more annotations burnt in the image." The term of art "burnt" is explained in ¶ 0002, which states: "The annotations are typically burnt in by overlaying an arbitrary intensity value of text on the image." The term "overlaying" clearly means that the annotations are added, as recited in claim 33.

Furthermore, the Brief Description of Drawings section describes Figure 2 as being "a flowchart generally representing the sequence of steps of an image processing algorithm in accordance with some embodiments of the invention." Block 28 in Figure 2 contains the legend "Screen Capture Image with Burnt Annotation". Obviously, there can be no "burnt annotation" in the image in the absence of the annotation being added to the

image.

Accordingly, the recited step of adding a textual annotation to image data finds clear support in the specification and the Section 112 rejection is mistaken.

II. Section 103(a) Rejection of Claims 33-44

In ¶ 6 of the February 22, 2007 office action, claim 33 was finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Ikeshoji (US 5,761,339) in view of Applicants' admitted prior art. The Applicants submit that this rejection is mistaken for the following reasons.

The Examiner broadly states that Ikeshoji "is directed to enhancing or correcting images that are annotated grayscale images." The Applicants respectfully submit that the teaching of Ikeshoji is not that broad. Ikeshoji states in numerous places that his invention is intended for use in removing stains or scratches from photographs by electronically scanning the photograph and then electronically removing the stain or scratch. Ikeshoji neither discloses nor suggests, for example, adjusting the brightness or contrast of an image. To the extent that Ikeshoji teaches separating annotations from background image, removing stains or scratches from the background image, and then restoring the annotations to the cleaned-up background image, Applicants submit it would not have been obvious to apply that teaching to images having burnt annotations, as the Examiner contends. There is no mention or suggestion in Ikeshoji that the electronically scanned photographs have burnt

annotations added to their electronic images. Accordingly, Applicants respectfully submit it would not have been obvious to apply the technique of Ikeshoji to images having burnt annotations, i.e., annotations added to images after the images are acquired but before the images are enhanced.

The Applicants submit that dependent claims 34-44 are allowable at least for the same reasons that claim 33 is allowable.

III. Section 103(a) Rejection of Claims 45-48

In ¶ 6 of the February 22, 2007 office action, claim 33 was finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Ikeshoji in view of Applicants' admitted prior art, and further in view of Macleod, Bloomberg and Gonzalez. Applicants submit that this rejection is mistaken for the same reasons, set forth above, that claim 33 is allowable and for the following additional reasons.

As noted above, Ikeshoji is concerned with removing stains from photographs or pictures. Ikeshoji teaches that colored stains can be removed by a process of matching the histograms of the stained portion to the histograms of the unstained portion of the photo or picture. Ikeshoji neither discloses nor suggests removing hue and saturation data from a color image, processing the remaining brightness component, and then restoring the hue and saturation components, as recited in Applicants' claim 45. Since Ikeshoji neither discloses nor suggests enhancing the unstained portions of a color image,


Applicants respectfully submit it would not be obvious to combine the color processing techniques disclosed in the Gonzalez article with Ikeshoji.

The Applicants submit that dependent claims 46-48 are allowable at least for the same reasons that claim 45 is allowable.

In view of the foregoing, the Applicants submit that claims 33-48 are in condition for allowance. Accordingly, it is respectfully requested that the Final Rejection be overturned and that this application be allowed.

Respectfully submitted,

May 21, 2007
Date


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CERTIFICATE OF MAILING

The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date set forth below.

May 21, 2007
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